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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/811,275	03/26/2004	Jayanta Basak	JP920030278US1	2158
7590 Frederick W. Gibb, III McGinn & Gibb, PLLC Suite 304 2568-A Riva Road Annapolis, MD 21401				
03/25/2008				
EXAMINER KENNEDY, ADRIAN L				
ART UNIT		PAPER NUMBER		
2129				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/811,275

**Applicant(s)**

BASAK ET AL.

**Examiner**

ADRIAN L. KENNEDY

**Art Unit**

2129

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4-8,10-12,14 and 15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-8,10-12,14 and 15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Examiner's Detailed Office Action***

1. This Office Action is responsive to **Amendment After Non Final**, filed **December 12, 2007**.
2. **Claims 1-2, 4-8, 10-12, and 14-15** will be examined.

***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-2, 4-8, 10-12, and 14-15 fail to provide a tangible result, and there must be a practical application, by either
  - a) transforming (physical thing) or
  - b) by having the FINAL RESULT (not the steps) achieve or produce
    - a using (specific, substantial, AND credible),
    - concrete (substantially repeatable/non-unpredictable), AND
    - tangible (real world/non-abstract) result.**

A claim that is so broad that it reads on both statutory and non-statutory subject matter, must be amended. A claim that recites a computer that solely calculates a mathematical formula is not statutory.

The courts have also held that a claim may not preempt ideas, laws of nature or natural phenomena. The concern over preemption was expressed as early as 1852. See Le Roy v. Tatham, 55 U.S. (14 How.) 156, 175 (1852) ("A principle, in the abstract, is a fundamental truth;

an original cause; a motive; these cannot be patented, as no one can claim in either of them an exclusive right.”); Funk Bros. Seed Co. v. Kalo Inoculant Co., 333 U.S. 127, 132, 76 USPQ 280, 282 (1948).

Accordingly, one may not patent every “substantial practical application” of an idea, law of nature or natural phenomena because such a patent “in practical effect would be a patent on the [idea, law of nature or natural phenomena] itself.” “Here the “process” claim is so abstract and sweeping as to cover both known and unknown uses of the BCD to pure-binary conversion. The end use may (1) vary from the operation of a train to verification of driver's licenses to researching the law books for precedents and (2) be performed through any existing machinery or future-devised machinery or without any apparatus.” Gottschalk v. Benson, 409 U.S. 63, 71-72, 175 USPQ 673, 673 (1972).

The Courts have found that subject matter that is not a practical application or use of an idea, a law of nature or a natural phenomenon is not patentable. As the Supreme Court has made clear, “[a]n idea of itself is not patentable.” Rubber-Tip Pencil Co. v. Howard, 20 U.S. (1 Wall.) 498, 507 (1874); taking several abstract ideas and manipulating them together adds nothing to the basic equation. In re Warmerdam, 31 USPQ2d 1754 (Fed. Cir. 1994). Specifically,

- 1) The applicant's claimed invention is directed to a **process** (Claims 1 and 6), **machine** (Claim 7) within the meaning of 101.
- 2) The applicant's claimed invention encompasses the **abstract idea** of classifying vertically partitioned data.

Embodiment 1 (Claims 1, 6, and 7): A method and machine for classifying

vertically partitioned data.

3) The claimed Embodiment 1 does not produce a **physical transformation**; therefore, the examiner has looked for a **useful, concrete and tangible result** to establish a practical application.

Embodiments 1- Final result is determining the mutual consistency of classifiers.

*Tangible: The determining of the mutual consistency of mutual classifiers is not a tangible result.* This position is based on the fact that determining is merely abstract ideas. Furthermore, determining is not an abstract idea and is not practically applied therefore it is not a tangible result.

4) Embodiments 1 does not appear to preempt the abstract idea, since they are not so broad and sweeping as to cover ever substantial series of steps to perform the classifying of vertical partitioning of data, and instead require a specific series of steps to do so. Therefore, claims 1-2, 4-8, 10-12, and 14-15 are not statutory.

#### ***Response to Arguments***

The examiner hereby acknowledges the Applicant's Remarks dated December 12, 2007. While there were not arguments made regarding the previously presented Office Action, the examiner has presented a new grounds of rejection as set forth above.

#### ***Conclusion***

Examiner's Opinion:

The examiner has considered the applicant's arguments in light of the claimed invention.

Furthermore, the examiner respectfully reminds the applicant that “**during examination, the claims must be interpreted as broadly as their terms reasonably allow**”. (MPEP 2111.01 [R-5] I)

Should the applicant choose to amend, the Examiner respectfully suggests that the applicant consider including a statement along the lines of “wherein the produced mutual consistency for each classifier is used when vertically partitioning data” (possible solution to 101 issues.). Finally, regarding the term “mutual consistency” (Claims 1, 6, and 7), the examiner asserts that because the term is not a term of art, that it is defined at paragraph 0024 as a “subset C of classifiers [satisfying] Equation [2]”. If this assertion is incorrect please indicate that in subsequent correspondence.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Claims 1-2, 4-8, 10-12, and 14-15 are rejected.

***Correspondence Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adrian L. Kennedy whose telephone number is (571) 270-1505. The examiner can normally be reached on Mon -Fri 8:30am-5pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Vincent can be reached on (571) 272-3080. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ALK

/David Vincent/  
Supervisory Patent Examiner  
Technology Center 2100